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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,511	03/07/2001	Benjamin Slotznick	8899-31U1	5297

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/801,511	Applicant(s) SLOTZNICK, BENJAMIN	
	Examiner Maikhanh Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 06/09/2005 to the original application filed 03/07/2001.
2. Claims 1-23 are currently pending in this application. Claims 1, 9, 11, and 19 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-17 and 19-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Ballard** (U.S. 6,449,765 – filed 08/1999) in view of **Applicant Admitted Prior Art** (APA).

As to independent claim 9:

- a. Ballard teaches a method of supplementing the display of a desired home web page on a display screen of a user's terminal by using a setup web page having an address, the setup page having access to an address of a supplemental web page to be displayed (*Abstract*), the method comprising:

- (i) a browser of the user's terminal automatically navigating to the setup web page address when the user logs onto the Internet (*e.g., An end user sets a preference accessible through the Web browser software to define the URL for the first web page to be accessed and displayed upon logging onto the global computer network. Such first web page is referred to as the default home page; col.5, line 64-col.6, line 3*); and
 - (ii) the setup web page receiving the supplemental web address (*e.g., Once the user is logged onto the global computer network and the homepage is displayed, the user can browse other web page. Typically, the homepage has a set of hyperlinks which are preprogrammed with URL addresses for other information resources; col.6, lines 4-8*).
- b. Ballard does teach the supplemental web page, but is silent on the use of a floating window (to display the supplemental web page).
- c. APA teaches the use of a floating window (*e.g., launch a smaller 'floating' window displaying the site 'called a "child" window'; page 2, lines 9-13*).
- d. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from APA in the system of Ballard because APA's teachings allowed the user to retrieve two web page and simultaneously view the web pages on the separate windows.

As to dependent claim 10:

Ballard teaches the user's terminal stores a cookie file including the supplemental web page address, the method further comprising: the setup page web using address

information in the cookie file to automatically cause the supplemental web page to be displayed (*e.g., the URL address of such referral web site start page is stored in a 'cookie' which identifies such URL address as having the status of being the referral web site start page; col.9, lines 3-18*).

As to independent claim 1:

The rejection of claim 9 above is incorporated herein in full. Additionally, Ballard further teaches the browser window displays the home page (*e.g., the Web browser software to define the URL for the first web page to be accessed and displayed. Such first web page is referred to as the default home page; col.5, line 1-col.6, line 3 and Fig.4*).

As to dependent claim 2:

It includes the same limitations as in claim 10, and is similarly rejected under the same rationale.

As to dependent claim 3:

Ballard teaches the setup web page is located in a file on the user's terminal or is remotely located from the user's terminal (*col.3, lines 42-50 & col.5, lines 52-67*).

As to dependent claim 4:

Ballard teaches the setup web page opens up at least one other window on the user's display screen to display advertising or other information (*col.6, lines 28-35 and Fig.4*).

As to dependent claim 5:

Ballard teaches the user selecting the supplemental web page by clicking on a displayed page element while visiting the supplemental web page (*col.8, line 65-col.9, line 1*), wherein the page element is selected from the group consisting of an icon, a link and a

button; and automatically storing the address of the supplemental web page in a file on a remote server or in a cookie file in the user's terminal (*col.9, lines 3-43*).

As to dependent claim 6:

Ballard teaches the setup web page is an HTML page (*e.g., Web page; Abstract*).

As to dependent claim 7:

Ballard teaches the setup web page is a CGI script (*e.g., Java programs or other program or scripts; col.6, lines 61-63*).

As to independent claim 11:

Note the rejection of claim 9 above. Claim 11 is the same as claim 9, except claim 11 is an article of manufacture claim and claim 9 is a method claim.

As to dependent claims 12-17:

They include the same limitations as in claims 2-7, and are similarly rejected under the same rationale.

As to independent claim 19:

Note the rejection of claim 9 above. Claim 19 is the same as claim 9, except claim 19 is an article of manufacture claim and claim 9 is a method claim.

As to dependent claim 20:

It includes the same limitations as in claim 10, and is similarly rejected under the same rationale.

As to dependent claims 21-22:

Ballard teaches the user selecting the supplemental web page from a plurality of different web page addresses; and storing the address of the supplemental web page for subsequent use by the setup web page (*col.2, lines 14-67 and col.8, line 64- col.9, line 10*).

As to dependent claim 23:

Ballard teaches the user selecting the supplemental web page from a plurality of different web page addresses (*col.2, lines 14-67 and col.8, line 64- col.9, line 10*).

4. Claims 8 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Ballard** in view of **Applicant Admitted Prior Art (APA)** as applied to claims 1 and 11 above, and further in view of **Teibel et al.** (U.S. 6,353,451 – filed 12/1998).

As to dependent claims 8 & 18:

- a. Teibel teaches the CGI script is configured such that the floating window appears in the foreground of the display screen (*e.g., child window is in the foreground; col.1, lines 15-18 and Fig.2*), and the home page appears in the background of the display screen (*e.g., parent window is in the background; col.1, lines 15-18 and Fig.2*).
- b. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Teibel's teachings in the system of Ballard as modified by APA because it would have provided the capability for designing cues relating to active and inactive window.

Response to Arguments

5. Applicant's arguments filed 06/09/2005 have been fully considered but they are not persuasive.

a. Applicant argues that *the concept of a setup page is thus completely absent from Ballard*. (Remarks, page 3, line 4)

In response, Ballard meets *a setup page (an end user sets a preference accessible through the Web browser software to define the URL for the first web page to be accessed and displayed upon logging onto the global computer network. Such first web page is referred to as the default home page; col.5, line 64-col.6, line 3)*

The scope of the claimed "*a setup page*" clearly transcends the more narrow scope that Applicant attempts to impute through argument. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art, *In re Self*, 213 USPQ 1 (CCPA 1982), *In re Priest*, 199 USPQ 11 (1978). The recited "*a setup page*" is clearly subject to a broad interpretation as detailed in the rejections maintained above. The Examiner has a duty and responsibility to the public and to Applicant to interpret the claims as broadly as reasonably possible during prosecution. *In re Prater*, 415 F.2d 1 393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt* 21 1 F.3d

1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (1989) "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."

- b. *Applicant argues that this use of a floating window is an improper hindsight reconstruction of Applicant's invention.* (Remarks, page 3, 3rd full para.)

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170

USPQ 209 (CCPA 1971).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cragun et al. U.S. Patent No. 6,177,936 Issued: Jan. 23, 2001

Friskel et al. U.S. Patent No. 6,683,629 Issued: Jan. 27, 2004

Melero et al. U.S. Publication 2002/0111879 A1 Pub. Date: Aug. 15, 2002

7. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William G. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/17/2005